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Mailed: June 3, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Engineered Products, Inc.

Serial No. 76511361

James Stone Craven of Craven & Reid, LLC for Engineered Products, Inc.

Dominick J. Salemi, Trademark Examining Attorney, Law Office 106
(Mary Sparrow, Managing Attorney).

Before Hohein, Hairston and Holtzman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Engineered Products, Inc.
to register ENGINEERED PRODUCTS for the following goods, as
amended:¹ "storage and materials handling systems, namely metal

¹ Applicant offered this amendment in response to the examining attorney's requirement in the first Office action for an acceptable identification of goods. Although the examining attorney did not object to or otherwise act on the proposed amendment and continued throughout the appeal to refer to the goods as originally identified, applicant has relied upon the identification of goods as amended. Accordingly, we deem the above amendment to be acceptable and as the operative identification of goods.

racks, metal pallets, conveyors and conveyor controls sold as a unit," in Class 6.²

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act. When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs. An oral hearing was not requested.

The examining attorney initially refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of its goods. In response, and without any argument that the mark is inherently distinctive, applicant amended the application to seek registration under Section 2(f) of the Act. The amendment was accompanied by a declaration of five-years substantially exclusive and continuous use signed by James Stone Craven, applicant's attorney. The examining attorney rejected the 2(f) evidence and ultimately issued a final refusal under Section 2(e)(1) based on genericness.

Unless the question of inherent distinctiveness is clearly reserved, which in this case it was not, a claim of acquired distinctiveness under Section 2(f) is tantamount to a concession that the mark is not inherently distinctive. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6

² Serial No. 76511361, filed May 2, 2003, based on an allegation of first use and first use in commerce on June 1, 1955.

USPQ2d 1001, 1005 (Fed. Cir. 1988) and General Foods Corp. v. MGD Partners, 224 USPQ 479, 485 (TTAB 1984). Under the circumstances, we find that applicant has conceded that the mark is merely descriptive, and that the only issues on appeal are whether the mark is generic and, if not, whether the evidence is sufficient to establish that the mark has acquired distinctiveness.

It is the examining attorney's position that ENGINEERED PRODUCTS is the generic name for the primary or salient feature of applicant's goods. According to the examining attorney, the term "aptly and commonly describes a salient feature of the system." (Final Action, unnumbered p. 2). In particular, the examining attorney argues that the term ENGINEERED PRODUCTS, when used in connection with storage and materials handling systems, "tells the public that said system was the result of scientific development and testing." (Id.)

In support of his position, the examining attorney has relied on a dictionary definition of "engineered" as meaning "to design or create using the methods or techniques of engineering"; a definition of "engineering" as "the practical application of the knowledge of the pure sciences as physics or chemistry as in the construction of [things]"; and a definition of "products" as

"a thing that is produced by labor."³ The examining attorney argues that the two words combined "result in a designation that means, literally, 'a thing made or created by the application of pure scientific principles.'" (Brief, unnumbered p. 4.)

The examining attorney has also submitted excerpts of three stories obtained from the NEXIS database consisting of a press release and two news wire stories. Relevant portions of those excerpts are set forth below (emphasis added).

- HEADLINE: European Commission focuses on human tissue engineering potential
BODY: ... "A specific Regulation on the conditions for placing on the market **tissue-engineered products** is being prepared. It will introduce a set of common rules designed to clarify the legal framework for business operators, as well as guarantee the highest level of safety for users and patients. Such common rules will ensure that **tissue-engineered products** circulate freely within the EU, thus making innovative therapies available to those who need them," ...
Commission of the European Communities (Copyright 2004; Press Release; IP: 04/85).
- SECTION: FINANCIAL NEWS
DISTRIBUTION: TO BUSINESS AND TECHNOLOGY EDITORS
...
HEADLINE: Blue Martini Software and eLogic Group Form Worldwide Partnership: Companies to Deliver a Complete Consulting and Technology solution For Manufacturers of **Engineered Products**
...
BODY: ...announced a worldwide marketing and consulting partnership focused on delivering complete consulting and technology solutions for manufacturers of **engineered products**. Through the partnership the

³ We take judicial notice of these definitions which the examining attorney submitted for the first time in his brief.

companies will enable manufacturers' sales and distribution partners to streamline the quote and order lifecycle, assisting them in ordering **engineered products** for their clients, ...
PR Newswire (May 16, 2002).

- DISTRIBUTION: TO BUSINESS AND ENVIRONMENTAL EDITORS
...

BODY: Republic Engineered Products LLC ...is North America's leading supplier of special bar quality (SBQ) steel, a highly **engineered product** used in axles, drive trains, suspensions and other critical components of automobiles, off-highway vehicles and industrial equipment. ...
PR Newswire (August 20, 2003).

In addition, the examining attorney points to applicant's specimen, which refers to applicant's company as "...engineers... for warehousing, storage and handling systems."

The examining attorney concludes based on the evidence that ENGINEERED PRODUCTS "has become virtually synonymous with any type of good produced according to scientific principles" and that the use of the term is so "widespread" that "it can be safely said it is as readily employed and recognized as a term of art in any and all industries designing and manufacturing goods of any kind." (Brief, unnumbered p. 4.)

Applicant, on the other hand, argues that there is no evidence that the relevant public refers to storage and materials handling systems as "engineered products." Applicant maintains that while "'Engineered Products' is certainly an apt name for a product such as storage and materials handling systems, ... it is

not used as a generic name for [such goods]" and that "[a]lptness is insufficient to prove genericness." (Brief, p. 5.)

The test for determining whether a mark is generic involves a two-step inquiry. The first step is to identify the genus (category or class) of goods at issue. The second step is to determine whether the term sought to be registered is understood by the relevant public primarily to refer to that genus (category or class) of goods. See *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

The genus or general category of goods in this case is storage and materials handling systems, namely metal racks, metal pallets, conveyors and conveyor controls sold as a unit. *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("...a proper genericness inquiry focuses on the description of services [or goods] set forth in the [application or] certificate of registration").

The question, then, is whether the term "ENGINEERED PRODUCTS" is generic as applied to applicant's goods. The test for making this determination turns upon how the term is perceived by the relevant public, that is, the primary significance of the mark to the relevant public. *Magic Wand*,

Inc., supra; and H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., supra.

The relevant public for applicant's goods is not specifically identified or defined in the record, but from the face of the identification of goods, it seems likely that the relevant purchasers for a storage and materials handling system comprised of metal racks, pallets and conveyors sold as a unit would be industrial purchasers, such as plant engineers and factory managers, and not ordinary consumers.

The examining attorney has the burden of proving genericness by "clear evidence" of the relevant public's understanding thereof. In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). We find no clear evidence of record as to how these purchasers would perceive ENGINEERED PRODUCTS in relation to the identified goods. Even assuming press releases and wire service stories, the only NEXIS evidence of record, can be accorded some probative value, in this case they are of no such value. The press release describes a Commission report of the European Communities concerning "human tissue engineering." The wire service reports are directed to business, technology and environmental editors, not purchasers. Thus, the NEXIS evidence fails to reflect the relevant public's understanding of the term "engineered products."

Moreover, it is not clear from any of the evidence relied on by the examining attorney that "engineered products" designates applicant's particular category of products. One of the NEXIS excerpts is irrelevant, referring to "tissue-engineered" products; and another excerpt refers ambiguously to "engineered products" without defining the nature or category of those products. The third excerpt, describing steel as a "highly engineered product," if anything, refers only to an "engineered" component of a finished product. Even assuming applicant's storage and handling systems contain "engineered" components or raw materials, there is no evidence that the relevant public would recognize applicant's storage and handling systems as "engineered products." Similarly, neither the dictionary definitions, even when pieced together, nor applicant's specimen demonstrates generic use of "engineered products" for applicant's category of goods.

In view of the foregoing, and since any doubt on the matter of genericness should be resolved in applicant's favor, we find that the Office has not met its burden of showing that ENGINEERED PRODUCTS is generic for applicant's goods. A different and more complete record, however, presented perhaps in the context of an inter partes proceeding, may produce a different result.

As we noted earlier, applicant, by amending the application to seek registration under Section 2(f), has conceded that

ENGINEERED PRODUCTS is not inherently distinctive but is instead merely descriptive of its goods. Moreover, applicant admits that ENGINEERED PRODUCTS is an apt name for its storage and materials handling systems. (Brief, p. 5.)

The burden is on applicant to show acquired distinctiveness, and the more descriptive the term, the heavier that burden becomes. *Yamaha International Corp. v. Hoshino Gakki Co.*, supra. In view of the highly descriptive nature of ENGINEERED PRODUCTS, we find that applicant has not met this burden.⁴

Applicant argues that it is a leading manufacturer of quality storage racks and materials handling systems; that applicant has achieved nationwide recognition for its goods; and that the mark ENGINEERED PRODUCTS has acquired distinctiveness through substantially exclusive and continuous use in connection with these goods for at least fifty years.⁵ However, Mr. Craven, in his declaration, has attested to only five rather than fifty years use. Applicant has submitted no evidence to support its claim of fifty-years use nor any evidence of how the purchasing public would view the designation.

⁴ While, as applicant argues, "aptness" may not be sufficient to prove genericness (see *In re American Fertility Society*, supra), an "apt" name for a product would, without question, be considered highly descriptive of that product.

⁵ Applicant mentions for the first time in its brief that it is the owner of two registrations and two other applications for marks which we note are entirely different from mark herein. This evidence is untimely and in any event has no bearing on the question of whether the mark in the present application has acquired distinctiveness.

Considering the highly descriptive nature of ENGINEERED PRODUCTS, applicant's evidence of five-years use, without evidence which would help determine the extent of purchaser exposure to the mark, such as sales figures or advertising expenditures relating to the mark, is not persuasive that the mark has acquired distinctiveness for applicant's goods.

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed.